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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,084	03/12/2004	Greg Siwak	10759-00048	8523
7590 Patrick W. Rasche Armstrong Teasdale LLP Suite 2600 One Metropolitan Square St. Louis, MO 63102		04/02/2007	EXAMINER POLLICOFF, STEVEN B	
			ART UNIT 3728	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/02/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/799,084	<b>Applicant(s)</b> SIWAK ET AL.	
	<b>Examiner</b> Steven B. Pollicoff	<b>Art Unit</b> 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 January 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

Request for reconsideration of the restriction requirement is denied. The restriction was made final in the previous office action, 10/11/06. Applicant may petition the restriction requirement to the technology center directors. MPEP 818.03(c) and 1002.02(c)(2); 37 CFR 1.144.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Franco et al., (US Pat 4,506,769).

With respect to claims 1-5,7,8,10 and 11, Franco discloses a dual use product package/duffel bag (Franco Fig 1) comprising a non-food product/footwear (Fig 4); a non-rigid rectangular base (column 2 lines 65-68) defining a cavity capable of being used as a lunchbox (Fig 3) holding said non-food product and capable of containing a food product (i.e. edible food , beverage, etc...) once the nonfood product is removed; a cover (18) configured to close said cavity; and a closure member located at or near a top edge of said base (24) (i.e. zipper mechanism) fastening said cover to said base; and a handle attached to said base (26).

With respect to claim 6, Franco discloses that said cover is integrally formed with said base, said cover folded over said base in a closed position (Fig 3 ref 22).

With respect to claim 9, Franco discloses that the package includes an expandable section to hold food/non-food items in the cavity (Fig 4 ref 70).

With respect to claim 12, Franco discloses that a portion of the base is insulated (Fig 3 ref 41; see also column 4, lines 46-49).

With respect to claims 13,14,16 and 17, Franco discloses a footwear package comprising: a support surface (Fig 3 see bottom surface of base ref 10); a plurality of soft side walls (Fig 3 see also column 2, lines 65-68) extending from said support surface and defining a cavity (Fig 3 generally) comprising footwear (Fig 4), wherein at least one of said side walls comprises a flap (18) folded over the remaining side walls to define a cover over said cavity; and a zipper (24) selectively coupling and uncoupling said flap and said remaining side walls at or near the top edge of the support surface; and a handle (26).

With respect to claim 15, Franco discloses that at least one of said support surface and said side walls comprises a soft material and a stiffening element (column 5, lines 30-35).

With respect to claims 18 and 19, in order to further limit the claims there must be some distinction based upon the intended use recited. "However, in apparatus, article, and composition claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed

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invention from the prior art.” (see M.P.E.P. § 2111.02 THE INTENDED USE MAY FURTHER LIMIT THE CLAIM IF IT DOES MORE THAN MERELY STATE PURPOSE OR INTENDED USE.) The examiner can see no structural differences between the claimed invention and the prior art based upon the intended use recited of the cavity being “packed with footwear at a point of purchase” and being “packed with footwear at a first point in time and packed with lunch items at a second point in time.” Therefore, the claims are rejected for not further limiting the independent claim 13.

With respect to claims 20 and 21, Franco discloses the package further comprising an expandable section (Fig 4 ref 70) and that the base is convertible into a duffel bag (Fig1 and Fig 4).

### ***Response to Arguments***

Applicant's arguments filed 1/11/07, with respect to the anticipation of claims 1-21 under Franco, have been fully considered but they are not persuasive. In response to applicant's claim 1 argument that Franco fails to describe a dual use product package holding products for sale, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Certainly, the Franco bag is capable of being sold with products in it. It should also be noted that the amended claim language “at a point of sale” does not result in a structural difference between the claimed invention and the activity bag of Franco. Applicant further argues that Franco does not teach that the container is configured to contain food products.

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Again, the language "configured to" is considered intended use functional language and will not be considered to constitute a limitation. Therefore, since the Franco package is capable of containing food products, it meets the functional language.

In response to applicant's arguments regarding claims 1 and 13, the recitations "footwear package" and "product package" have not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). The preamble phrases "product package" and "footwear package" in no way limit the claimed invention. It is reasonable to conclude that a "product package" includes any packaging that houses a product for any intended use and footwear can be packaged in any number of packages of varying sizes, shapes, colors and intended uses.

Applicant's arguments, with respect to the rejection of claims 1-21 under Davis have been fully considered and are persuasive. Thus, the rejection has been withdrawn.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See pto-892.

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**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. Pollicoff whose telephone number is (571)272-7818. The examiner can normally be reached on M-F: 7:30A.M.-4:00P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571)272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

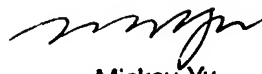
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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*SBP*  
SBP 3/21/07

  
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